

S/N 09/938,778

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Nikhil M. Deshpande et al.	Examiner:	Alexander Jamal
Serial No.:	09/938,778	Group Art Unit:	2643
Filed:	August 24, 2001	Docket:	884.491US1
Title:	ADAPTIVE INSTANT MESSAGING		
Assignee:	Intel Corporation	Customer Number:	21186

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The applicants request review of the final rejection dated 13 June 2005 in the above-identified application. The applicants respectfully traverse all rejections. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below:

I. Claims 1, 2, 14-16, and 21-22 were rejected under 35 USC § 102(e) as being anticipated by Waites et al. (U.S. 6,788,769, Waites). The applicants respectfully traverse.

Waites relates to an internet directory system and method using telephone number based addressing.¹ The "directory system utilizes a user's telephone number for the respective user's e-mail address and web home page."² However, Waites does not show or describe transmitting an instant message or sending an instant message as claimed. In fact, the examples of communication in Waites are limited to sending a user e-mail, accessing a user's web site,³ a non-computer user calling from a telephone,⁴ and sending a fax.⁵ Waites also indicates that the directory system provides unified messaging enabling users to transmit communications using e-mail, telephone, paging, or fax.⁶ Instant messaging is not included in this list.

Instant messaging is substantially different from these other forms of communication. The Background of the instant application states:

¹ Waites, Title.

² Waites, column 6, lines 22-25.

³ Waites, column 7, lines 57-65.

⁴ Waites, column 8, lines 37-59.

⁵ Waites, column 13, lines 17-31.

⁶ Waites, column 11, lines 24-43.

“Whereas email is a store-and-forward system based on short-lived connections, recipients listening for instant messages remain connected to their server on a long-lived connection. This long-lived connection allows instant messages to be delivered in close to real time.”⁷

Other distinguishing features of instant messaging are also described in the Background. The applicants have submitted several references in the Information Disclosure Statement filed 13 March 2002 that distinguish instant messaging from other forms of communication.

Waites refers to the directory system as offering the capability to locate the person’s instant message address using a person’s telephone number.⁸ Waites also says that the directory system “provides addressing for unified messaging” including instant messaging.⁹ Waites does not show or describe transmitting an instant message or sending an instant message as claimed in independent claims 1, 14, and 21. The final Office Action cited the “Field of the Invention” in Waites that mentions instant messaging along with other forms of communication.¹⁰ The “Field of the Invention” does not describe an instant messaging system, but is a broad reference to the field of electronic communications.

The final Office Action also states that several features are “inherent” in Waites without any supporting evidence. The MPEP states that missing matter must be “necessarily present” in the reference to support a rejection based on inherency.¹¹ The MPEP further states that the examiner must provide a basis to support a determination that the allegedly inherent characteristic necessarily flows from the teaching of the art:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”¹²

Multiple Federal Circuit decisions emphasize the need for the PTO to furnish evidence in support of claim rejections. For example, the Federal Circuit addressed citation of “basic knowledge and common sense” in rejections in *In re Zurko*:

“With respect to core factual findings in a determination of patentability, however, the Board [Board of Patent Appeals and Interferences] cannot simply reach conclusions based on its own

7 Description, page 1, lines 25-30.

8 Waites, column 8, lines 29-37.

9 Waites, column 2, lines 55-62.

10 Final Office Action, page 2.

11 MPEP 2112.

12 MPEP 2112. Emphasis in original.

understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”¹³

The final Office Action has not provided evidence of a basis in fact and/or technical reasoning to reasonably support its contention that the “originating device inherently comprises a controller” or that the “terminals inherently comprise software” as is required by the MPEP and *In re Zurko*.

The applicants respectfully submit that Waites does not show all of the features recited in claims 1, 2, 14-16, and 21-22, and that claims 1, 2, 14-16, and 21-22 are in condition for allowance.

II. Claims 3-5, 18, and 23-25 were rejected under 35 USC § 103(a) as being unpatentable over Waites in view of Andrews. The applicants respectfully traverse.

The final Office Action states that:

“It would have been obvious...that the receiving pager of Waites’ system could comprise a text-to-speech converter for the advantage of providing a user with an additional interface (hearing) to communicate with.”¹⁴

The MPEP requires a suggestion and a reasonable expectation of success for a rejection under 35 USC § 103.¹⁵ A Federal Circuit opinion states that the suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art.¹⁶ The Federal Circuit has particularly emphasized the need for the PTO to furnish evidence in support of claim rejections under 35 USC § 103 in *In re Lee*:

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness....The factual inquiry whether to combine references must be thorough and searching....It must be based on objective evidence of record.”¹⁷

The Federal Circuit stated that the “need for specificity pervades this authority” requiring a teaching, motivation, or suggestion to select and combine references.¹⁸ The Federal Circuit has

¹³ *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

¹⁴ Final Office Action, page 5.

¹⁵ MPEP 2143 quoted in the applicant’s response filed 28 March 2005.

¹⁶ MPEP 2143 citing *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

¹⁷ *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

¹⁸ *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

expressed this need for specificity in *In re Dembiczak*:

“[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.....the showing must be clear and particular.”¹⁹

The final Office Action provided a motivation for combining Waites and Andrews (quoted above), but did not provide evidence of motivation in the prior art as is required by *In re Vaeck* and *In re Lee*. The final Office Action is also missing evidence of a reasonable expectation of success of this combination of Waites and Andrews as required by *In re Vaeck* and *In re Lee*. The final Office Action is improperly using hindsight in combining Waites and Andrews contrary to *In re Dembiczak*.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claims 3-5, 18, and 23-25, and that claims 3-5, 18, and 23-25 are in condition for allowance.

III. Claims 19-20 and 26-29 were rejected under 35 USC § 103(a) as being unpatentable over Waites in view of Andrews. Claim 17 was rejected under 35 USC § 103(a) as being unpatentable over Waites in view of Ogle et al. (U.S. 6,430,604, Ogle). Claims 11 and 13 were rejected under 35 USC § 103(a) as being unpatentable over Andrews in view of Waites. The applicants respectfully traverse.

There is no cited evidence of a suggestion for these combinations of references put forth in the final Office Action. In each rejection, the final Office Action provided motivations for combining the references listed above, but did not provide evidence of motivation in the prior art as is required by *In re Vaeck* and *In re Lee*. The final Office Action is also missing evidence of a reasonable expectation of success of the listed combinations of references as required by *In re Vaeck* and *In re Lee*. The final Office Action is improperly using hindsight in combining the listed references contrary to *In re Dembiczak*.

¹⁹ *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claims 11, 13, 17, 19-20, and 26-29, and that claims 11, 13, 17, 19-20, and 26-29 are in condition for allowance.

The Examiner is invited to telephone Applicant's attorney at (612) 373-6973 to facilitate the prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


Respectfully submitted,

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Date 13 October 2005

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 13th day of October, 2005.

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